

REMARKS

In response to the Final Office Action mailed November 24, 2008 ("Office Action")¹, the response for which is due March 24, 2009 with a one-month extension of time, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

I. Interview Summary

Applicant acknowledges, with appreciation, the telephonic interview conducted on February 26, 2009, between the undersigned and Examiner Kim. Also present on the call were Kristie Decelles of assignee NetScout Systems, and Maura K. Moran (Reg. No. 31,859) and Reza Sadr (Reg. No. 63,292) of Finnegan. The substance of the interview is made of record in the remarks below.

II. Status and Disposition of the Claims

In the instant application, claims 1-15, 21-29, 32-34 and 40-47, of which claims 1, 21, 40 and 42 are independent, were previously pending and under consideration on the merits.

In the Office Action, the following actions were taken:

- 1) Claims 1-7, 12-15, 21-28, 34 and 40-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Application Pub. No. 2002/0083344 by Vairavan (hereinafter *Vairavan*) in view of US Patent No. 5,796,942 to Esbensen (hereinafter *Esbensen*), and US Patent No. 6,772,349 to Martin et. al. (hereinafter *Martin*).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

- 2) Claims 8-11, 29, 32 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Vairavan* in view of *Esbensen* and *Martin*, and further in view of US Patent No. 7,159,237 to *Schneier* et al. (hereinafter *Schneier*).

III. Amendments to the Claims

In this response to the Office Action, Applicant amends claims 1-3, 8-13, 15, 21-24, 28, 29, 32-34, and 40-44, and adds new claims 48-53. Many of the amendments add missing antecedent bases or improve readability. Upon entry of the amendments, claims 1-15, 21-29, 32-34, and 40-53 will be pending in this application.

Support for the amendments may be found, among other places, in the following parts of the Specification:

- FIG. 1 depicts LAN/WAN link 15 linking a first network (WAN 10) to the combination of Gateway 20 and one or more LAN segments 30. Also, probe 40 is installed on the LAN/WAN link 15, outside the combination of Gateway 20 and one or more LAN segments 30, and IDS 50 is also outside the combination of Gateway 20 and one or more LAN segments 30. Further, IDS 50 is linked to probe 40 via the second network link 45.
- "Intrusion attacks typically originate from outside an organization's network, in that they are directed into an organization's network via its "connection" to the outside world-which is typically the WAN interface. However, since existing IDSs are typically located on a LAN, the IDS typically sees a mixture of internal traffic, which is generally safe, and external traffic, which potentially contains intrusion attacks" (paragraph [0005], emphases added).
- "In one implementation, IDS functionality is added to an existing network probe. The probe converts WAN traffic into an Ethernet format traffic that an existing IDS can monitor. Including the IDS-support functionality within the probe enables an IDS to see only WAN traffic. Hence, false positives arising from wrongly interpreting (benign) LAN traffic are eliminated. Furthermore, WANs are generally slower than LANs; so the IDS is now exposed to a reduced amount of traffic. False negatives resulting from performance shortcomings of an IDS are therefore minimized" (paragraph [0011], emphases added).

- “The filter module 70 can include pre-defined filters 140 and, optionally, a set of user-defined filters 150. The filters can utilize predefined sets of criteria to determine whether a packet should be forwarded. For example, the pre-defined filters 140 can be configured to filter traffic that is not useful to the IDS 50 in diagnosing an intrusion attack. For example, management network traffic may be filtered out by the pre-defined filters 140. ... The filtered traffic can be stored in the audit trail buffer 90, as described above” (paragraph [0045]).

Applicant thus respectfully requests reconsideration.

III. Response to Rejections

A. The Rejection of Claims 1-15, 21-29, 32-34 and 40-47 under 35 U.S.C. §103 Should be Withdrawn.

In the Office Action, claims 1-15, 21-29, 32-34 and 40-47, 1-7, 12-15, 21-28, 34 and 40-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Vairavan* in view of *Esbensen* and *Martin* alone or in combination with *Schneier* (see Office Action at pages 2, 3, and 8). Applicant respectfully traverses the above-cited rejections of the claims under 35 U.S.C. §103(a), because, for each of the claims, a prima facie case of obviousness has not been established.

As addressed in the interview, the Examiner contends that the recited features of a probe located outside the second network, and an IDS located outside the second network and configured to not receive data packets exchanged inside the second network are addressed in the cited references. Applicant respectfully submits that neither *Vairavan* nor *Esbensen* nor *Martin* nor *Schneier* teaches or suggests those features that are recited in claim 1. No agreement was reached during the interview, but the Examiner agreed to consider amendments to resolve the 35 U.S.C. § 103(a) rejections. Applicant herein makes amendments to place claims in allowable condition,

and respectfully requests such consideration of amended claim 1, because neither *Vairavan* nor *Esbensen* nor *Martin* nor *Schneier* discloses at least the following features in amended claim 1:

- “a probe located outside the second network,”
- “an intrusion detection system (IDS) for detecting the intrusion initiated in the first network toward the second network,” and
- “the IDS located outside the second network and configured to not receive data packets exchanged inside the second network.”

See amended Claim 1. Applicant respectfully traverses the above-cited rejections of the claims under 35 U.S.C. § 103(a), because, for each of the claims, a *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459

(1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that “[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis.” M.P.E.P. §2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a §103 rejection.

Here, a *prima facie* case of obviousness has not been established. The scope and content of the prior art has not been properly determined, nor have the differences between the claimed invention and the prior art been properly ascertained. Accordingly, a reason *why* the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not clearly articulated.

In this application, the cited references do not teach or suggest the above-cited recitations of independent amended claim 1. For at least these reasons, claim 1 is allowable under 35 U.S.C. §103(a). For at least the reasons stated above with respect to claim 1, claims 2-15, 44, and 45 are allowable at least since they depend, directly or indirectly, from claim 1.

Independent claims 21, 40 and 42, although different in scope from claim 1, recite elements similar to claim 1, and therefore, for at least the reasons stated above with respect to claim 1, are also allowable. Further, for at least the reasons stated above with respect to claim 1, claims 22-29, 32-34, 41, 43, 46, and 47 are allowable at least since they depend, directly or indirectly, from one of claims 21, 40, and 42.

Accordingly, Applicant's claims 1-15, 21-29, 32-34 and 40-47 are patentably distinct from *Vairavan*, *Esbensen*, *Martin* and *Schneier*, alone or in combination. Applicant respectfully requests the rejection under 35 U.S.C. § 103(a) of claims 1-15, 21-29, 32-34, and 40-47 to be withdrawn.

IV. New Claims

Each of the newly added claims 48-53, depends, either directly or indirectly, from one of the independent claims 1 and 21, and thus includes limitations similar to those discussed above, which are not taught or suggested by *Vairavan*, *Esbensen*, *Martin*, or *Schneier*, alone or in combination. Therefore, Applicant contends that, at least for the same reasons, new claims 48-53 are patentable.

V. Conclusion

In view of the foregoing response and remarks, Applicant respectfully requests the reconsideration of the rejections, the reexamination of this application, and the timely allowance of the pending claims. Please grant any extensions of time required to

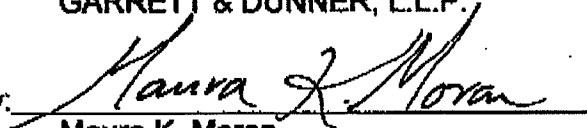
enter this response and charge any additional required fees to our deposit account
06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 24, 2009

By:


Maura K. Moran
Reg. No. 31,859